

R marks

In the Office Action mailed June 26, 2002, claims 7-21, 25, 29 and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,742,060 issued to Shiokawa, The Pesticide Manual, Worthing et al., and EP0,148,526 in the name of Van Dyck et al.

Rejections under 35 U.S.C. §103(a)

Claims 7-21, 25, 29 and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,742,060 issued to Shiokawa, The Pesticide Manual, Worthing et al., and EP 0,148,526 in the name of Van Dyck et al. Claims 8, 11-13, 15-18, 25, 29 and 30 have been cancelled, thus obviating any grounds for rejection based upon those claims. Applicants respectfully disagree with the Examiner's contention regarding the cited art.

U.S. Pat. No. 4,742,060 issued to Shiokawa teaches at col. 53, lines 60-67,

"The active compounds according to the invention can be present in their commercially available formulations and in the use forms, prepared from these formulations, as a mixture with other active compounds, such as insecticides, baits, sterilizing agents, acaricides, nematocides, fungicides, growth-regulating substances or herbicides. The insecticides include, for example, phosphates, carbamates, carboxylates, chlorinated hydrocarbons, phenylureas, substances produced by microorganisms."

Applicants respectfully note that Shiokawa discloses potentially thousands, if not hundreds of thousands of compounds of his compound of formula (I) which has at least twelve independent variables. The above-reproduced passage states that any of those numerous compounds may be combined with one of eight different classes of substances, likely encompassing at least thousands of substances. Therefore, if applicants understand the Examiner correctly, he is asserting that the above-reproduced passage from Shiokawa would motivate one of ordinary skill in the art to combine from about 10^{-6} to 30 parts by weight of 1-(6-chloro-3-pyridylmethyl)-2-nitroimino-imidazolidine and from about 0.01 to about 90 parts by weight of $\pm\alpha$ [2-(4-chlorophenyl ethyl)- α -(1,1-dimethylethyl)-1H-1,2,4-triazole-1-ethanol and apply that

composition to a technical material as is instantly claimed. Applicants contend that Shiokawa fails to teach the instantly claimed combination.

The Pesticide Manual, Worthing et al., teaches tebuconazole, triadimefon and triadimenol as stated by the Examiner. However, Worthing et al. fails to teach the combination of any of those with an insecticide.

EP 0,148,526 in the name of Van Dyck et al., teaches at page 7, lines 20-29,

"As insecticidal agents which may be used in combination with the azoles of formula (I) the following classes of products may be considered: insecticides having a natural origin, e.g., nicotine, rotenone, pyrethrum and the like; chloridated hydrocarbons, e.g., lindane, chlordane, endosulfan and the like; organic phosphor compounds, e.g., diazinon, parathion, dichloorvos, dimethoate and the like; carbamates, e.g., carbaryl, aldicarb, methiocarb, propoxur and the like; biological insecticides, e.g., products originating from *Bacillus thuringiensis*; synthetic pyrethroids, e.g., permethrin, allethrin, cypermethrin, halothrin and the like."

Nowhere does Van Dyck et al. teach or suggest combining from about 10^{-6} to 30 parts by weight of 1-(6-chloro-3-pyridylmethyl)-2-nitroimino-imidazolidine and from about 0.01 to about 90 parts by weight of $\pm\alpha[2-(4\text{-chlorophenyl ethyl})-\alpha-(1,1\text{-dimethylethyl})-1\text{H-}1,2,4\text{-triazole-}1\text{-ethanol}$ and apply that composition to a technical material as is instantly claimed.

The Examiner concedes at page 3 of the instant Office Action that, "(t)he above references fail to teach specific examples of the old insecticides and old fungicides together." Applicants respectfully direct the Examiner's attention to *In re Rouffet*, 149 F.3d 1350, 1356-7; 47 U.S.P.Q.2D (BNA) 1453, 1456-7 (Fed. Cir., 1998) wherein the Federal Circuit stated,

("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability."

The court went on to state, at 1458, that, "... the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed."

Applicants contend that the Examiner here has failed to show such reasons. Therefore, applicants contend that nothing in the teaching of Shiokawa, Worthing et al., and Van Dyck et al., individually or in combination, would lead one of ordinary skill to the instantly claimed invention and respectfully request the Examiner reconsider and reverse his rejection of claims 7, 9, 10, 14 and 19-21 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,742,060 issued to Shiokawa, The Pesticide Manual, Worthing et al., and EP 0,148,526 in the name of Van Dyck et al.

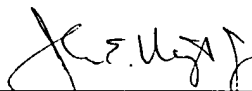
C nclusi n

Applicants have amended Claims 7, 14 and 19-21 and have cancelled Claims 8, 11-13, 15-18, 25, 29 and 30. Applicants contend that such amendment adds no new matter and finds support in the specification. Attached hereto, please find pages captioned "Version with markings to show changes made."

Applicants submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for claims 7, 9, 10, 14 and 19-21. If the Examiner is of the opinion that the instant application is in condition for other than allowance, he is requested to contact the applicants' Attorney at the telephone number given below so that additional changes to the claims may be discussed.

Respectfully submitted,

By



John E. Mrozinski, Jr.
Attorney for Applicants
Reg. No. 46,179

Bayer Corporation
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741
(412) 777-8336
FACSIMILE PHONE NUMBER:
(412) 777-8363

E

/jme/JM0090

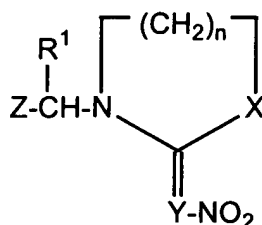
Version with markings to show changes made

IN THE CLAIMS:

Claims 8, 11-13, 15-18, 25, 29 and 30 have been cancelled.

Please amend the claims as follows:

7. (Twice Amended) A method of protecting a technical material comprising applying to the technical material a composition comprising:
from about 10^{-6} to 30 parts by weight of [an insecticide having the formula (I)]



wherein X is NH or S,

Y is CH or N,

Z is 2-chloro-5-pyridyl or 2-chloro-5-thiazolyl,

R¹ is hydrogen or methyl, and

n is 0 or 1] 1-(6-chloro-3-pyridylmethyl)-2-nitroimino-imidazolidine; and
from about 0.01 to about 90 parts by weight of $\pm\alpha$ [2-(4-chlorophenyl ethyl)- α -(1,1-dimethylethyl)-1H-1,2,4-triazole-1-ethanol [a fungicide].

14. (Twice Amended) A method of protecting a wood product selected from the group consisting of wood and wood composites against attack by insects comprising applying directly thereto a composition comprising an amount sufficient to effect protection thereof of [the compound] 1-(6-chloro-3-pyridylmethyl)-2-nitroimino-imidazolidine and from 0.01 to 90 parts by weight of [a fungicide] $\pm\alpha$ [2-(4-chlorophenyl ethyl)- α -(1,1-dimethylethyl)-1H-1,2,4-triazole-1-ethanol, wherein the composition is applied in [manner selected from the group consisting] at least one of soaking said wood product in or with said compound, impregnating said wood

product with said compound, brushing said compound onto said wood product, spraying said compound onto said wood product, and dipping said wood product in said compound.

19. (Twice Amended) The method of Claims 7 or 14 [15], wherein the composition comprises from about 0.0005 to 15 parts by weight of the insecticide and from about 0.05 to about 50 parts by weight of the fungicide.

20. (Twice Amended) The method of Claims 7 or 14 [15], wherein the composition comprises from about 0.005 to 2 parts by weight of the insecticide and from about 0.1 to about 30 parts by weight of the fungicide.

21. (Twice Amended) The method of Claim [15]Z, wherein the technical material is a wood product.

As explicitly set forth in **37 C.F.R. Section 1.121(c)(1)(ii)**, **last sentence**, a marked up version does not have to be **supplied** for an added claim or a cancelled claim as it is sufficient to state that a **particular** claim has been added, or cancelled, and this has been so stated in the Amendment.

In particular, in the instant application, Claims 8, 11-13, 15-18, 25, 29 and 30 have been cancelled.